

**REMARKS**

In the present amendment remarks, the rejections in the Office Action will be considered in the order presented in the Office Action. In the amendment, the new claim format is being used. However, the original claims 1 – 23 are not retyped but merely attached as an Exhibit to this amendment.

Initially, the status of various claims will be considered. Following the present amendment, the claims present in this case are 1 – 23, 33 – 50, 53 – 58 and 67 through 81. Claims 48 and 49, previously considered allowable, were rejected as anticipated by the Ma patent. These claims have now been amended to include the limitation that the upper surface of the sections is “substantially continuous”. Of course the Ma patent is actually quite foreign to the invention; and it is presumed that with this change these claims will again be allowed.

Claims 1 – 23, and 39 – 41 were allowed.

Claims 51 and 52 have been cancelled in view of the previous presentation of claims 57 and 58. It is noted that claims 57 and 58 were indicated as being allowable subject to (1) double patenting, now obviated by the cancellation of claims 51 and 52, and (2) the recapture rejection. New claims 72 and 73, patterned after claims 57 and 58 include (1) the section removability and (2) that the sections extend over substantially the entire area of the inner sole. In addition, claim 72 and claim 73 include (3) height limitations of the sections not found in original claim 20 and (4) the limitation the “said grid pattern of resilient sections constituting means for providing a multiplicity of ....” also not found in original claim 20. With the substance of claims 51 and 52 and new limitations in new claims 72 and 73, to include all of points (1) – (4), it is presumed that the recapture rejection is overcome, and that claims 72 and 73 are allowable.

Dependent claims 59 – 66, which refer back to claims 33, 36 – 39 and 42 – 44, respectively, were considered to be directed to allowable subject matter, “except for 35 USC 112 rejections”. Although none of these claims are mentioned in paragraphs 6 and 7 of the Office Action some amendments were made to overcome §112 objections. Dependent claims 59 – 66 have now been cancelled, and these claims are presented as claims 74 through 81; and it is presumed that these claims are now considered to be allowable.

Claims 53 (Dependent on 67) and claims 67 – 69 were indicated as being allowable except for the recapture rejection. However, the two independent claims 67 and 68 both include

(1) the removable sections and (2) the grid of sections extending over substantially all of the inner sole and as well as limitations (3) and (4) noted above relative to claims 72 and 73. It is understood from section 1 of the Office Action that, with these two limitations present in the claims that one aspect of the recapture rejection has been overcome. In addition where original claim 20 (parent case) did not include the third and fourth limitations, this recapture rejection based on cancelled claim 20 is not applicable. Accordingly, it is presumed that claims 53 and 67 – 69 are allowable.

To summarize, and as noted above, the claims active in this case at the present time include the original patented claims 1 – 23, claims 33 – 50, 53 – 58, and 74 – 83. Of these claims, it is understood that claims 1 – 23 (original claims), 39 – 41, 48, 49 (previously allowed), 53 (dependent on 67), 67 – 69, and 72 through 81 should now be considered allowable.

This leaves claims 33 – 38, 42 – 47, 50, 54 – 58, 70 and 71 which would still stand under the rejections as set forth in the Office Action of April 11, 2003.

The rejections applied to the remaining claims as listed in the preceding paragraph will now be considered.

### Recapture

Section 1 of the Office Action deals with “recapture”; and claims 37, 50, 57, 58, 61 and 67 – 71 were rejected on this basis.

First, it is respectfully noted that 35 USC 251, last paragraph clearly contemplates that, in general, if a reissue application is timely filed, that broadened reissue claims are permitted.

Regarding recapture, let us consider amended claim 58, for example, which now includes:

“said grid pattern of resilient sections constituting means for providing a multiplicity of sections that sway laterally independently of one another in response to forces applied by the foot, thereby reducing shear stresses on the bottom of a foot as the user walks along; and

“said sections having a height and a transverse extent, with the height being substantially equal to or greater than said transverse extent.”

This claim is now directed toward the nature of these resilient sections, and the fact that they have a defined height and provide means for enabling swaying, a limitation that is in accordance with the final paragraph of 35 USC 112. This type of language was not included in any of the cancelled claims of the parent application, such as original claim 20 referenced in the

Office Action. Further, this is a very significant distinguishing feature from the flat constructions of Andrews and Kellerman.

It is also noted that each of this group of claims at least has the first of these two quoted limitations (with slightly different phrasing), and others of these claims have other limitations.

Accordingly, we have a situation similar to that present in the Ball Corp. v. U.S. decision cited in the Office Action, in which claim 58 (and the other claims) is broader in some respects and significantly narrower in some important respects as compared with claims dropped or amended in the file history of the parent application and patent..

In the Ball reissue case the inventor omitted one structural limitation which had been included in the patent prosecution, but added new structural limitations including dielectric material and an electrical signal feed assembly. Similarly, in the present case, claim 58 and other claims include new and important structural limitations not involved in the file history limitations. Accordingly, guided by the Ball case, none of the present claims as amended should be barred by the recapture doctrine.

It is also noted in passing that the Clement case involves a different type of situation where the reissue tried to broaden the temperature range, which had been limited during prosecution, without significantly narrowing the claims in other areas.

It is also submitted that, where the basic reissue statute contemplates that broadened reissue claims are generally permitted, the suggestion that a limitation added to one claim (claim 17) in the parent case must be included in all reissue claims, is clearly improper. Here, where each claim under consideration includes important limitations not present in any original claim, rejection on the basis of recapture is inappropriate.

### **Double Patenting**

This rejection has been obviated by the cancellation of claims 51 and 52.

### **35 USC 112 Rejections**

It is suggested in the Office Action that the limitation regarding removability of the sections must be included, based on lack of "enablement" for embodiments where the sections are not specified as removable. In this regard we again reference Col. 3, lines 20 – 24 which

states a “broader” aspect of the invention; and the reference to the preceding paragraph is only to “the type” of section disclosed in the preceding paragraph, and not to their removability.

Reference is also made to Fig. 27 of the drawings where the sections 468 may be retained and partially deflated, see col. 13, line 5; and to Col. 10, line 8, where it is stated relative to another embodiment that no sections need be removed.

Accordingly, regarding enablement there are at least 3 separate areas of the specification which indicate that the sections need not be removable. Further, Figs. 3 and 5 inter alia show constructions where all of the elements are in place, with none removed. Accordingly, where the specification has full support for embodiments where the sections are not removable, it is respectfully requested that this rejection is inappropriate and should be withdrawn.

#### **Indefiniteness**

Claims 45, 70 and 71 were rejected as indefinite in the use of “sway laterally to a substantial extent”. It is respectfully noted that all 3 of these claims now includes the phrase in question in a “means for” clause in accordance with 35 USC 112, last paragraph, which authorizes the use of functional language of this type in claims.

Further, concerning the use of “substantially” in claim language, this has been approved in a number of Federal Circuit cases, including *Seattle Box Co. vs. Industrial C&P Inc.*, 221 USPQ 568, 225 USPQ 357 (Fed. Cir. 1985) and *Andrew Corp. v. Gabriel electronics, Inc.*, 6 USPQ 2d 210 (Fed. Cir. 1988). Particularly in the present case where the phrase is included in a “means for” clause, and where the prior art has no significant swaying action, it is submitted that “swaying to a substantial extent” is an appropriate and meaningful limitation.

Concerning the objections to claims 50, 57 and 58 regarding the “independently vertically movable resilient sections”, we agree with the Examiner’s suggestion that alternative language would be preferable, and have amended the claims to indicate that it is the upper surface of the sections which is vertically movable. In addition the sections are now defined in certain claims as being compressible as well as resilient to more clearly define the structure.

**Supplemental Declaration**  
**Of Kelly Long**

Attention is also directed to the Supplemental Declaration of Kelly Long. In this Declaration, Ms. Long provides additional information on total sales of the assignee showing that the sales of products as claimed, "had unusually rapid acceptance and increased sales growth", and has become a substantial part of the assignee's sales. Further, in her Declaration, she attributes this success to the merits of the invention and its superiority as compared with other medical alternatives.

**Prior Art Rejections**

The rejection of previously allowed claims 48 and 49 on the Ma patent is noted, and these claims have been amended, as noted above to specify that the upper surface of the sections form a substantially smooth and continuous surface. Where the mode of operation of the Ma patent is so different from that of applicant, in that the Ma structure has many high pressure points which would cripple a diabetic patient, the re-allowance of these claims is solicited.

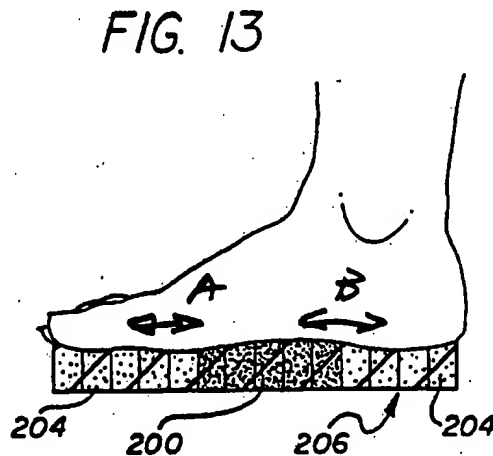
The prior art rejections of the remaining claims based on Andrews, Kellerman, Moronaga, Grim and Cavanagh have been the subject of interchange about the propriety of the combinations of references in several Office Actions and amendments; and we hereby incorporate by reference our arguments from prior amendments dealing with these references.

The basic prior art rejection of all claims includes the assertion that the claims are unpatentable over the Kellerman patent in view of the Andrews patent. The Kellerman patent discloses a shoe insert with large flat removable sections forming an array on the bottom of the insert, and an upper very low friction surface onto which the patient's foot will slide; and Kellerman's insert is intended to relieve calluses, corns, bunions and the like. The Andrews patent has fixed location depressions into which flat inserts may be located or removed with the depressions preventing any significant swaying of the inserts. In order to combine the references, the Kellerman insert would have to be turned upside down, and the engaging surface for the foot would have to be changed from a low friction surface.

However there is no teaching whatsoever to justify a complete reorganization of the two patents. As well as turning the Kellerman device upside down, the disclosures of the two patents

would have to be turned inside out to form an anticipation. Thus, instead of the low friction, hard slippery surface taught by Kellerman, soft resilient sections which have high frictional engagement with the foot are employed and claimed in applicant's device. Reference is again made to the recent Federal Circuit cases of *In re Lee*, 61 USPQ2d 1430 and *McGinley v. Franklin Sports, Inc.*, 60 USPQ2d 1001 where such far-fetched combinations of references were rejected, and patentability was found.

As shown to advantage in fig. 13 of the drawings, set forth below, the arrows A & B represent the swaying of the sections.



With the upper surfaces of the sections being of relatively soft and resilient material, they remain in contact with areas of the foot (or the sock or stocking) and merely sway back and forth, as the patient walks, thereby absorbing the shear forces which would otherwise have a deleterious effect on diabetic patients or others with tender feet.

We recognize that it is possible to piece together references to build up a "pro-forma" rejection of the claims. However, the present invention is a revolutionary approach not really suggested in any legitimate way by any of the references or any valid combination thereof.

It is further noted that we have now included "means for..." language in many of the claims to follow the authorized language of 35 USC 112, last paragraph. In this way, the nature of the swaying action achieved by the tall sections is positively brought into the claims, and clearly distinguishes from any possible combination of the prior art.

Reference is also made to 35 USC 103 where patentability is based on unobviousness to one "having ordinary skill in the art to which the subject matter pertains". With regard to the present invention, such a person having "ordinary skill in the art" would be familiar with the foot problems of diabetic patients and persons with similar foot problems. Many of the references, such as the Kellerman patent and the Ma patent are far afield from the problems of diabetic patents, with ulcerated feet, or patients with poor foot circulation, or tender feet. Accordingly, persons "of ordinary skill in the art" would not look to these patents for solutions to the problems of such patients.

In this regard, the various Declarations and materials presented to the Patent Office in the course of the prosecution of this application have clearly shown the unobviousness of the claimed subject matter to persons "of ordinary skill" in this field; and these Declarations and attachments are hereby incorporated by reference into this response.

Incidentally, following discussions with the inventors, Reissue Declarations are being sent to all inventors with reference to the present claims.

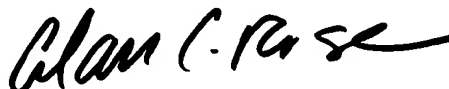
In conclusion, it is submitted that all of the claims are now in condition for allowance, and a Notice of Allowability is respectfully solicited, subject of course to the submission of acceptable Reissue Declarations. Thank you.

**The Commissioner is hereby authorized to charge any additional filing fees under 37 C.F.R. § 1.16, or application processing fees under 37 C.F.R. § 1.17, which may be required now or during the pendency of this application, or credit any overpayment to Account No. 16-2230. A duplicate copy of this sheet is enclosed.**

In closing we wish to thank Examiner Patterson for the interviews which were courteously granted, and for the thorough consideration she has given this application.

In view of the foregoing points and authorities, an early Notice of Allowance is solicited.

Respectfully submitted,



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Enclosures:

- (1) Supplemental Declaration of Kelly Long
- (2) Print of Patent Claims from Parent Issued Patent